

### **REMARKS**

Claims 1-3 (claims 4-5 are withdrawn from consideration) were examined and reported in the Office Action. Claims 1-3 are rejected. Claims 1-5 remain.

Applicant requests reconsideration of the application in view of the following remarks.

#### **I. Claims Rejected Under 35 U.S.C. 102(b)**

It is asserted in the Office Action that claims 1-2 are rejected under 35 U.S.C. § 102(b), as being anticipated by Japanese Patent Laid Open No. Hei JP 8-309232 (“JP 8-309232”). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

‘[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). ‘The identical invention must be shown in as complete detail as is contained in the ... claim.’ (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant’s claim 1 contains the limitations of

[a]n apparatus comprising: a rotor for a centrifugal separator, the rotor having storing holes each for storing a sample tube with a cap that are formed to be inclined with respect to an axis such that an open end of each of the storing holes is directed toward the axis, wherein contact portions each coming into contact with an outer surface of the cap of the sample tube are formed in open end sides of the storing holes, and the contact portions respectively have notches at portions thereof which face the axis.

JP 8-309232 relates to the angle rotor of the centrifugal separator, and Applicant is fully aware of this patent application. JP 8-309232 is concerned with “a finger notch,” and it is structured in such a way that the finger notch is constituted by shaving off the portion nearer to the center of the rotation of the neighborhood, leaving a tube hole. Unlike Applicant’s claimed invention, JP 8-309232 does not give any thought to an outer surface of cap 6 of the sample tube. Applicant notes that if a centrifugal separation is performed in the state where cap 6 is put on sample tube 4, since the portion of this cap rotates in the state where it is protruded from sample hole 3 to the upper part, the portion of cap 6 is pulled with a centrifugal force to the outside. Therefore, by the water pressure of the water that is contained in sample tube 4, sample tube 4 is deformed and bursts.

In order to solve the above-mentioned problem, Applicant’s claimed invention includes contact portion 32 to contact with an outer surface of cap 6 of sample tube 4. JP 8-309232, however, does not teach, disclose or suggest “contact portions each coming into contact with an outer surface of the cap of the sample tube are formed in open end sides of the storing holes, and the contact portions respectively have notches at portions thereof which face the axis.”

Applicant’s claim 1 asserts the contact portion that contacts the outer surface of the cap portion of the sample tube at the open end side of the storing hole of the rotor, and the notch was provided in the portion facing the rotor shaft line in this contact portion. Therefore, JP 8-309232 and Applicant’s claimed invention are completely distinguishable from each other.

Further, JP 8-309232 does not teach, disclose or suggest

a rotor for a centrifugal separator, the rotor having storing holes each for storing a sample tube with a cap that are formed to be inclined with respect to an axis such that an open end of each of the storing holes is directed toward the axis, wherein contact portions each coming into contact with an outer surface of the cap of the sample tube are formed in open end sides of the storing holes, and the contact portions respectively have notches at portions thereof which face the axis.

Since JP 8-309232 does not disclose, teach or suggest all of Applicant's claim 1 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to JP 8-309232. Thus, Applicant's claim 1 is not anticipated by JP 8-309232. Additionally, the claim that directly depends on amended claim 1, namely claim 2 is also not anticipated by JP 8-309232 for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejections for claims 1-2 are respectfully requested.

## **II. Claims Rejected Under 35 U.S.C. 103(a)**

It is asserted in the Office Action that claim 3 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over JP 8-309232 in view of U. S. Patent No. 4,832,678 issued to Sheeran ("Sheeran"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03,

[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

(*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *All words in a claim must be considered* in judging the patentability of that claim against the prior art. (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), *emphasis added*.)

Applicant's amended claim 3 directly depends on amended claim 1. Applicant has addressed JP 8-309232 regarding claim 1 above in section I.

As asserted above, JP 8-309232 does not teach, disclose or suggest

a rotor for a centrifugal separator, the rotor having storing holes each for storing a sample tube with a cap that are formed to be inclined with respect to an axis such that an open end of each of the storing holes is directed toward the axis, wherein contact portions each coming into contact with an outer surface of the cap of the sample tube are formed in open end sides of the storing holes, and the contact portions respectively have notches at portions thereof which face the axis.

Sheeran discloses a tube adapter for a centrifuge rotor is that has circumferentially extending latching surfaces that are engageable by the claws of a removal tool to extract the adapter from the recess of the rotor. And, the latching surfaces may be defined by a continuous groove or by a pair of groove segments formed on the body of the adapter. With Applicant's claimed invention, the tube of Fig. 5A is inserted in the adapter of Fig. 5, as shown in Fig. 4 and Fig. 5. In order to prevent the head of the sample container from becoming deformed at the time of the centrifugal action, as shown in Fig. 9, the adapter surrounds at least more than the head semicircle of the container, and therefore, prevents deformation.

Sheeran does not teach, disclose or suggest Applicant's claim 1 limitations of

the rotor having storing holes each for storing a sample tube with a cap that are formed to be inclined with respect to an axis such that an open end of each of the storing holes is directed toward the axis, wherein contact portions each coming into contact with an outer

surface of the cap of the sample tube are formed in open end sides of the storing holes, and the contact portions respectively have notches at portions thereof which face the axis.

And, Sheeran does not teach, disclose or suggest the limitations of amended claim 3 of “a contact portion coming into contact with an outer surface of a cap of the sample tube is formed in an open end side of the holding hole, the contact portion has a notch at a portion thereof...”

Therefore, even if JP 8-309232 were combined with Sheeran, the resulting invention would still not include all of Applicant's claimed limitations. Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to include

a rotor having storing holes each for storing a sample tube with a cap that are formed to be inclined with respect to an axis such that an open end of each of the storing holes is directed toward the axis, wherein contact portions each coming into contact with an outer surface of the cap of the sample tube are formed in open end sides of the storing holes, and the contact portions respectively have notches at portions thereof which face the axis.

Neither JP 8-309232, Sheeran, and therefore, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's claim 1, as listed above. Since neither JP 8-309232, Sheeran, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 1, as listed above, Applicant's claim 1 is not obvious over JP 8-309232 in view of Sheeran since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that directly depends from claim 1, namely claim 3, would also not be obvious over JP 8-309232 in view of Sheeran for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 3 is respectfully requested.

**CONCLUSION**

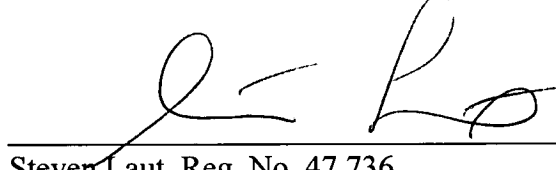
In view of the foregoing, it is submitted that claims 1-5 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

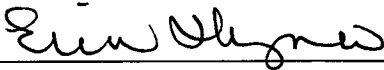
Dated: October 13, 2005

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on October 13, 2005.

  
Erin Flynn